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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,709	07/30/2003	Hitoshi Watanabe	00862.023164	5361

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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06/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/629,709

Applicant(s)

WATANABE, HITOSHI

Examiner

Thierry L. Pham

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/13/04, 5/4/06, and 7/12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- this action is responsive to the following communication: Nonprovisional application filed on 7/30/03.
- Claims 1-17 are pending.
- IDS filed on 8/13/04, 5/4/06, and 7/12/06 have been considered and herein attached (PTO 1449) with Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ozawa et al (US 6115137).

Regarding claim 1, Ozawa discloses an image input apparatus (digital camera 10, fig. 1) having a function for directly (directly transmitting image data to printer 12, fig. 1) transmitting a digital image to an image output apparatus, comprising:

- obtaining means (obtaining printer's characteristics, fig. 12) for obtaining from the image output apparatus, data related (e.g. paper size information, fig. 12) to an image outputting function of the image output apparatus; and
- UI changing means (camera's control panel, fig. 13) for changing contents (e.g. contents as shown in fig. 13) of user interface displayed on a display device based on the data obtained by said obtaining means.

Regarding claim 3, Ozawa further discloses the image input apparatus according to claim 1, wherein said obtaining means performs data transmission/reception to/from the image output apparatus through a general purpose interface (interface 14, fig. 1), and obtains the data related to an image outputting function in text data.

Regarding claims 11 & 13: Claims 11 & 13 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1 & 3; therefore, claims 11 & 13 are rejected for the same rejection rationale/basis as described in claims 1 & 3 above.

Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Parulski et al (US 7027172).

Regarding claim 10, Parulski discloses an image output apparatus (printer 400, fig. 3b) which receives and outputs a digital image transmitted from an image input apparatus (digital camera 300, fig. 3a), comprising: transmission means (interface 342, fig. 2) for transmitting data related to a trimming image output function (trimming function, fig. 6) of the image output apparatus to the image input apparatus, upon establishing a communication procedure; and output means (marking apparatus 412, fig. 2) for outputting an image based on an image output condition set by the image input apparatus based on the data related to the trimming image (trimming image, fig. 6) output function.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-9, 12, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al as described in claims 1 & 11 above, and in view of Edmonds (US 20030161641).

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Regarding claims 2, 4-7, Parulski fails to disclose a user interface screen that excludes a user interface item related to an image outputting function not possessed by the image output apparatus.

Edmonds, in the same field of endeavor for printing, teaches a well-known example of a user interface screen that excludes (printer driver user interface as shown in fig. 4 only shows features that are only available at the selected printer, fig. 4) a user interface item related to an image outputting function not possessed by the image output apparatus.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify user interface of Parulski to include only features that are available by the printer as taught by Edmonds because of a following reason: (●) to prevent printing errors by only selecting features that are only available and can only process by the selected printer; (●) displaying only features that can be processed by the printer help reduce confusion among users, for example, if the selected printer does not have a trimming function or edgeless function, then, therefore, it is not necessary to display such features on the printer driver or user interface.

Therefore, it would have been obvious to combine Parulski with Edmonds to obtain the invention as specified in claims 2, 4-7.

Regarding claims 8-9 recite limitations that are similar and in the same scope of invention as to those in claims 2, 4-7 above; therefore, claims 8-9 are rejected for the same rejection rationale/basis as described in claims 2, 4-7.

Regarding claims 12, 14-17: Claims 12, 14-17 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 2, 4-7; therefore, claims 12, 14-17 are rejected for the same rejection rationale/basis as described in claims 2, 4-7 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham



GABRIEL I. GARCIA
PRIMARY EXAMINER